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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/878,908	06/19/1997	KARL-LUTZ LAUTERJUNG	VAS.0002US	8837
21906	7590	02/12/2008	EXAMINER	
TROP PRUNER & HU, PC 1616 S. VOSS ROAD, SUITE 750 HOUSTON, TX 77057-2631			PREBILIC, PAUL B	
			ART UNIT	PAPER NUMBER
			3774	
			MAIL DATE	DELIVERY MODE
			02/12/2008	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.



### ***Specification***

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: With regard to claims 32 and 65-66, the language requiring “substantially continuous contact with one or more windings for a complete turn of a particular winding” (claims 65 and 66) or “contact with another winding for a complete turn of a given winding” (claim 32) does not have antecedent basis from the specification. Furthermore, the new language of claims 65, 66, 67, 70, 81, and 82 lacks antecedent basis from the specification and may lack original support.

### ***Claim Objections***

Claim 32 is objected to because of the following informalities:

On lines 17-18 and line 24 of claim 32, the language “annular resilient deformable annular elements” is grammatically awkward because “annular” is used twice.

On lines 19, 20, 22, 26, and 27 of claim 32, the language “said annular elements” lacks clear antecedent basis because there are many annular elements previously claimed. The Examiner suggests, for example, changing “said annular elements” (on line 19) to ---said pair of annular elements of said third prosthesis--- in order to overcome this objection. Corresponding changes could be made to the other lines to overcome the objections thereto.

On lines 22-23 of claim 32, the language “said second prosthesis section” lacks antecedent basis. Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 65-73, 75-79 and 81-82 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The new language “planes of the loops being parallel and substantially coplanar” lacks original support, as does the language “flattened helical coil” and “helical coil of a plurality of closed loops.” Based upon the drawing and the original specification, it is not seen how this language can be said to have support therefrom.

With regard to claims 65, 67-73 and 81-82, the language “the loop wraps back upon itself” or “turned back upon itself”, or “each of said loops wrapping back upon itself” or “wire turned back upon itself” lacks original support in that the loops or wire lengths, as disclosed, are not wrapped in one direction for one loop and then turned back in an opposite direction for the next winding.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 65 and 75-79 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 65, the new language “the planes of said loops being parallel and substantially coplanar” and in claim 75, the new language “coplanar, and substantially parallel” is considered indefinite because planes can be either parallel or coplanar not both since these terms are mutually exclusive. Claims 76-79 are dependent upon claim 75 so they contain the same indefinite language.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claim 32 is provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 11 and 12 of copending Application

No. 11/496,162. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 11 and 12 are read on by the present claim 32 where the second section of claim 32 is equivalent to the second prosthesis of claims 11 and 12 and the fourth prosthesis of claim 32 corresponds to the third prosthesis of claim 12.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

### ***Response to Arguments***

Applicant's arguments filed November 26, 2007 have been fully considered but they are not persuasive.

In response to the traversal of the specification objection, the Applicant made no amendments to the claims or specification and merely pointed to the drawings for support. However, this was and still is considered inadequate. As pointed out in the objection, 37 CFR 1.75(d)(1) requires that "*the terms and phrases used in the claims must find clear support or antecedent basis in the description so that the meaning of the terms in the claims may be ascertainable by reference to the description.*" Since the figures don't have "*terms and phrases*", it is not seen how they can be used to meet this requirement. The fact that the Applicant failed to amend the specification suggests that the original specification lacks original support.

In addressing the Section 112, first paragraph rejections, the Applicant argues that the precise language need not be in the specification to meet the description requirement. However, the specification must convey to an ordinary artisan that the

Art Unit: 3774

inventor had possession of the invention. The Examiner asserts that this requirement has not been met because one cannot determine which of the various embodiments that the language added July 9, 2007 has support. One skilled in the art would have had to speculate as to where this language has support. For example, "helical" is not even used in the specification and the "coil" (only used on one paragraph on page 7 of the specification) is used in a manner more analogous to the meaning of "winding." So what can one of ordinary skill reasonably ascertain, without speculation, original support for a "flattened helical coil"? Moreover, the terminology "closed loops" normally refers to structures such as closed rings where there no beginning or end to the loop. However, based upon the disclosure, it is not seen how the loops are closed when Applicant has argued that the annular ring is a wrapping of a single length of wire (see page 7, lines 10-13 of the specification).

On page 3 of the previous Office action, the Examiner pointed out that "wrapped back upon itself" does not have original support because the wire is "not wrapped in one direction for one loop and then turned back in an opposite direction for the next winding." The Applicant merely stated that the language is clearly shown in the figures and that each of the loops must come back upon itself. Perhaps the Examiner misinterpreted this language because there was nothing in the specification that would give it a context and reference point. To the Examiner, "turned back upon itself" suggests a reversal of direction similar to the manner in which Marcade (US 5,676,696). The top of Figure 2 shows a wire turned back on itself to form a tip where element (156)

Art Unit: 3774

is attached. There is no such turned or wrapped back structure disclosed in the Applicant's specification so the Examiner asserts that it lacks original support.

With regard to the prior art rejection utilizing Dwyer, it has been withdrawn because Dwyer does not have a "wire turned back on itself" as claimed. The new language overlapping along radii is considered met when the radii are considered the wire radii. Since the claim does not specify which radii are being referenced, the radii of the touching wires are considered overlapping.





***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Applicant should specifically point out the support for any amendments made to the disclosure, including the claims (MPEP 714.02 and 2163.06). Due to the procedure outlined in MPEP 2163.06 for interpreting claims, it is noted that other art may be applicable under 35 USC 102 or 35 USC 103(a) once the aforementioned issue(s) is/are addressed.

Applicant is respectfully requested to provide a list of all copending applications that set forth similar subject matter to the present claims. A copy of such copending claims is respectfully requested in response to this Office action if the application is not stored in image format (i.e. the IFW system) or published.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Paul B. Prebilio whose telephone number is (571) 272-4758. He can normally be reached on 6:30-5:00 M-Th.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott can be reached on 571-272-4754. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for

Art Unit: 3774

published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Paul Prebilic/  
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Art Unit 3774